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Amended*

second paper layer each is manufactured from wood pulp and short fiber, the short fiber having a length within the range of about 3 to 20 mm and comprising polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof, and said adhesive layer being provided on the surface of said first paper layer having a blending ratio of short fibers to wood pulp that is larger than the blending ratio of short fibers to wood pulp of said second paper layer.

A version marked up to show changes made to the claim(s) relative to the previous version of the claim(s) is attached.

### Remarks

Claims 1 and 2 have been amended. Claims 1-4 are pending.

Examination and reconsideration of the application as amended is requested.

Support for the amendment to claims 1 and 2 can be found in the specification, for example, on page 5, lines 4-12.

### § 102 Rejections

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 488 727 ("Canary"). The Examiner stated that the short fibers of the present invention materially includes wood pulp. Canary teaches wood pulp fibers with a length between 2 and 5 millimeters.

Applicant has amended Claim 1 to further define the short fibers as comprising polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof. Therefore, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Canary has been overcome and should be withdrawn.

In the advisory action, the Examiner stated that the amendment fails to exclude the prior art of record. However, Canary fails to teach short fibers comprising polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof. While the comprising language may allow one to add additional materials to the short fibers, the term "comprising" still requires that all elements listed in the claims be present. Therefore, the short fibers in the present application

must include one of the listed polymers. Canary fails to teach such short fibers. Additionally, the Examiner requested that the claim amendments must be written in proper Markush format. However, the present claim amendments are not intended to be limited as a Markush group. Applicant invites the Examiner to present a rejection of the claim language based on a statutory requirement.

### **§ 103 Rejections**

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP Patent No. 2589357 ("NITTO DENKO") in view of Canary.

The Examiner stated that it would be obvious to one of ordinary skill in the art to make a NITTO DENKO adhesive sheet with Canary's two layer backing, motivated by the desire to improve the release property without tearing and breaking.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

NITTO DENKO is directed toward a tape backing of a single layer porous sheet of fibrous material (comprising wood pulp and short synthetic fibers) impregnated with a solution or aqueous dispersion of rubber at different levels on different surfaces. Canary teaches a paperboard product used to make shoe insoles. There is no reasonable expectation that the shoe insoles of Canary would function as a tape backing. Canary teaches modifying properties such as stiffness, mouldability, and flexibility. In the present application, Applicant points out that if the ratio of short fibers to wood pulp is too high, the sheet may have increased strength but become difficult to tear or cut by hand. (Page 3, lines 7-10.) Therefore, it is not reasonable to expect that a relatively stiff shoe insert will behave in such a way to act as a reasonable backing for an adhesive sheet. The reasonable expectation of success to modify the NITTO DENKO reference as stated by the Examiner cannot come from the Applicant's own disclosure.

The Examiner states that the Applicant is attacking the references individually. However, the combination of references must also rely on a reasonable expectation of success. Additionally, as stated above, Nitto in combination with Canary fails to teach all the limitations of the present amendments. All the claimed elements must be taught or suggested in the prior references.

The rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over NITTO DENKO CORP in view of Canary has been overcome and should be withdrawn. Claims 3 and 4 each add additional features to claim 2. Claim 2 is patentable for the reasons given above. Thus, claims 3 and 4 are also patentable.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Allowance of claims 1-4, as amended, at an early date is solicited.

The Examiner is invited to contact the undersigned representative to hasten the prosecution of this pending application.

Respectfully submitted,

September 10, 2008  
Date

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**Version With Markings to Show Changes Made**

1. (Twice amended) A paper backing, for supporting a secondary layer, which has a double-layer paper structure comprising a first paper layer and a second paper layer, said first paper layer and said second paper layer each being manufactured from wood pulp and short fibers, the short fiber having a length within the range of about 3 to 20 mm and comprising polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof, wherein said first layer has a blending ratio of short fibers to wood pulp larger than the blending ratio of short fibers to pulp in the second layer.

2. (Twice amended) An adhesive sheet comprising a paper backing and an adhesive layer provided on one of its surfaces, said paper backing having a double-layer paper structure comprising a first paper layer and a second paper layer, in which said first paper layer and said second paper layer each is manufactured from wood pulp and short fiber, the short fiber having a length within the range of about 3 to 20 mm and comprising polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof, and said adhesive layer being provided on the surface of said first paper layer having a blending ratio of short fibers to wood pulp that is larger than the blending ratio of short fibers to wood pulp of said second paper layer.